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OHS-289/Div

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Shunji OISHI, et al.

Serial No.: 10/627,620

Group: 1773

Filed: July 28, 2003

Examiner: Le, Hoa T.

FOR: MAGNESIUM HYDROXIDE PARTICLES, METHOD OF THE PRODUCTION THEREOF, AND RESIN COMPOSITION CONTAINING THE SAME

Date: November 4, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**EXPEDITED REQUEST FOR NOTIFICATION
OF CONSIDERATION OF PRIOR ART
UNDER MPEP §609 AND MPEP §2001.6(b)**

Sir:

Applicants respectfully request the Examiner to confirm the consideration of prior art filed with an IDS and considered in the parent application in accordance with the requirements of MPEP §609 and MPEP §2001.6(b).

Applicants note that the present application was filed July 28, 2003, under 37 CFR 1.53(b) as a divisional of parent application Serial No. 09/622,002, now U.S. Patent 6,676,920.

An information disclosure statement submitting a supplemental partial European search report and the references cited therein was filed in the parent application on July 24,

2003. Copies of the IDS, IDS transmittal letter, form SB/08A and stamped filing receipt are attached as Exhibit A.

By communication from the Examiner in the parent application dated December 5, 2003, copy attached as Exhibit B, Applicants were advised that the IDS and references had been considered and had been entered in the file of the parent application.

The parent application issued as U.S. Patent 6,676,920 on January 13, 2004, with the entered references listed thereon.

Applicants respectfully submit that the file of the parent application and the references cited therein were available to the Examiner in the present divisional application before the March 1, 2004 mail date of the first Office action in the present divisional application.

MPEP §609 states:

"The examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (B) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent." (MPEP §609(I) (A) (2)).

MPEP §2001.6(b) states:

"If the application under examination is identified as a continuation, divisional, or continuation-in-part of an earlier application, the examiner will consider the prior art cited in the earlier application. See MPEP §609. The examiner must indicate in the first Office action whether the prior art in a related earlier application has been reviewed. Accordingly, no separate citation of the same prior art need be made in the later application."

When filed, the present application was clearly identified as being a divisional of application Serial No. 09/622,002, now U.S. Patent 6,676,920.

A Notice of Allowance has been issued in the present application and, in reviewing the application prior to payment of the issue fee, Applicants find no indication, either in their paper file or in the electronic file wrapper at the USPTO on line PAIR site, that the prior art cited in the parent application has been considered as required by MPEP §609, nor any indication as part of the first Office action that the prior art in the parent application has been reviewed as required by MPEP §2001.6(b).

Accordingly, Applicants respectfully request confirmation that the Examiner has reviewed and considered the prior art cited in the parent application Serial No. 09/622,002, now U.S. Patent 6,676,920, in the examination of the present divisional

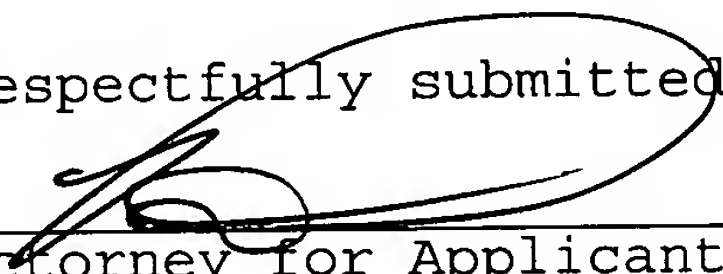
application, in accordance with MPEP §609 and MPEP §2001.6(b).

Alternatively, if the Examiner did not review and consider the prior art cited in the parent application, Applicants respectfully request that the present divisional application be restored to the Examiner for the specific purpose of considering the prior art cited in the parent application as required by MPEP §609 and MPEP §2001.6(b).

Inasmuch as the issue fee in the present application is currently due December 28, 2004, Applicants respectfully request that this matter be given priority and that it be handled on an expedited basis.

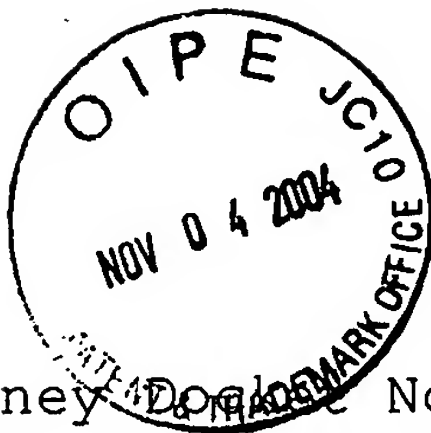
An early notice of allowance is respectfully requested.

Respectfully submitted,



Attorney for Applicant
Robert L. Haines
Reg. No. 35,533

SHERMAN & SHALLOWAY
P.O. Box 788
Alexandria, VA 22313
(703) 549-2282



FILING RECEIPT

EXHIBIT A

Attorney ~~Doyle~~ No. OHS-289

Date: July 24, 2003

Attorney: RLH

Inventors: Shunji OISHI, et al

Serial No. 09/622,002

Filed: August 11, 2000

Title: **MAGNESIUM HYDROXIDE PARTICLES, PROCESS FOR
PRODUCING THE SAME, AND RESIN COMPOSITION
CONTAINING THE SAME**



THE PTO STAMP HEREON ACKNOWLEDGES RECEIPT OF:

- (1) Filing Receipt;
- (2) Information Disclosure Statement Transmittal Letter;
- (3) Information Disclosure Statement;
- (4) Form SB/08A (2 pages);
- (5) Copies of all references listed on Form SB/08A.

SHERMAN AND SHALLOWAY
413 N. Washington Street
Alexandria, Virginia 22314
703-549-2282

FILE CHECK

Prepared by: RLH

Approved by: RLH

Copy reviewed:

Filed by:

PLEASE RETURN THIS FILE TO



UNITED STATES PATENT AND TRADEMARK OFFICE

EXHIBIT B

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,002	08/11/2000	Shunji Oishi	OHS-289	6015

7590 12/05/2003

Sherman & Shalloway
413 North Washington Street
Alexandria, VA 22314

EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

CLO 10

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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11

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

U.Application Control No.: 09/620,002

Art Unit : 1714

*The Information Disclosure Statement dated July 24, 2003 submitted to the office has enclosed the prior art on Form SB08A. The examiner has reviewed and considered the prior art statement and entered the prior art in the file of the instant application. On page 2 of the Disclosure Statement, applicants submit the statement that the claims as amended place the allowed claims outside the scope of the prior art and the examiner agrees with applicants' statement. The examiner has listed the prior art on PTO Form -892 and copy of the said Form-892 is enclosed. Thus the instant application is being returned to the Issue Department so that the instant application can pass to issue.

See Attachment:

[X] Information Disclosure Statement: PTO Form-892.

Margaret B. Medley
Margaret B. Medley
Primary Examiner
Art Unit: 1714



Notice of References Cited

Application/Control No.

09/622,002

Applicant(s)/Patent Under
Reexamination
OISHI ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-3,232,708	02-1966	Edward	423/161
*	B	US-5,843,389	12-1998	Elsner et al.	423/162
*	C	US-3,508,869	04-1970	Shoaff	423/639
*	D	US-4,246,254	01-1981	Miyata et al.	423/635
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

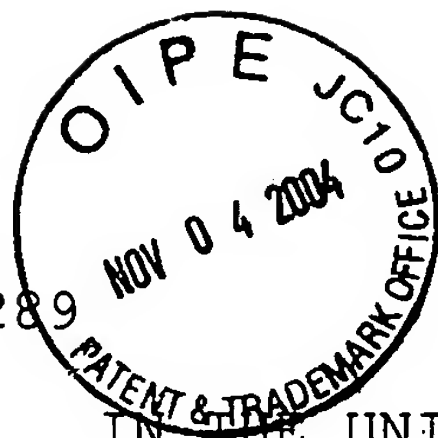
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
*	N	JP-7061812 A	03-1995	JP	Tateho Kagaku Kogyo KK	-
*	O	JP-02164713 A	06-1990	JP	Mitsubishi Mining & Ceme-	-
*	P	CN-1148570 A	04-1997	CN	Peop. Rep. China-	-
*	Q	JP-03170325 A	07-1991	JP	Mitsubishi Materials Corp	-
*	R	JP-2048414 A	02-1990	JP	Mitsubishi Mining & Cemen	-
*	S	EP-0221449 A	05-1987	EP	Pirelli Cavi Spa	-
*	T	JP-0442360 A	05-1992	JP	Toray Ind Inc.	-

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

OHS-289



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Shunji OISHI, et al.

Serial No.: 09/622,002

Group: 1714

Filed: August 11, 2000

Examiner: M. Medley

FOR: MAGNESIUM HYDROXIDE PARTICLES, PROCESS FOR PRODUCING THE SAME, AND RESIN COMPOSITION CONTAINING THE SAME

Date: July 24, 2003

The Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with their obligation under 37 C.F.R. §1.56, Applicants would like to call the Examiner's attention to the documents listed on the attached form SB-08A.

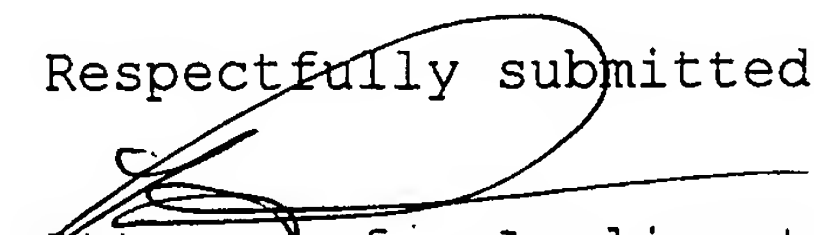
Applicants note that all of the documents listed are cited in the recently issued Supplementary Partial European Search Report in the corresponding European application and that this filing is being made solely in the interest of completing the record in the subject application.

A copy of the Supplementary Partial European Search Report is also included and provides reference to the relevant sections of the documents.

Applicants note that references EP 0 780 425 and U.S. 5,843,389 are of record in this application having been cited in the International Search Report. Applicants further note that the amendments to the claims of the subject application made February 24, 2003, and on which allowance of the subject application is based, place the allowed claims outside the scope of the references cited in the Supplemental partial European search Report.

Applicants are not aware at this time of any other prior art which could be considered to be relevant to the present application.

Respectfully submitted,


Attorney for Applicants
Robert L. Haines
Reg. No. 35,533

SHERMAN & SHALLOWAY
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Alexandria, Virginia 22313
(703) 549-2282



ATTORNEY'S DOCKET OHS-289
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:) Group Art Unit: 1714
)
Shunji OISHI, et al.)
) Examiner: M. Medley
Serial No. 09/622,002)
)
Filed: August 11, 2000)

For: MAGNESIUM HYDROXIDE PARTICLES, PROCESS FOR PRODUCING THE
SAME, AND RESIN COMPOSITION CONTAINING THE SAME

INFORMATION DISCLOSURE STATEMENT TRANSMITTAL LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

An Information Disclosure Statement is submitted herewith pursuant to 37 C.F.R. §1.97-1.98. Please note the following particulars:

[NOTE: One only of items a, b, c, and d must be checked.]

[] a. The enclosed statement is being filed within three months of the filing date of a national application, or within three months of the date of entry into the national stage as set forth in 37 C.F.R. §1.491 in an international application, or before the mailing date of a first Office Action on the merits, whichever event occurs last.

[] b. The enclosed statement is being filed after a first action on the merits but before the mailing date of a final action under 37 C.F.R. §1.113, or a notice of allowance under 37 C.F.R. §1.311.

The enclosed statement is accompanied by [check one]:

[] i. a certification in part (e) below as specified in 37 C.F.R. §1.97(e), or

[] ii. a check in the amount of \$ required by 37 C.F.R. §1.17(p).

[] c. The enclosed statement is being filed after the mailing date of a final action under 37 C.F.R. §1.113, or a notice of allowance under 37 C.F.R. §1.311, but before payment of the issue fee.

PETITION: It is requested that the information being submitted be considered. [NOTE: If box (c) is checked, the following two boxes must be checked.]

☐ PETITION FEE: A check for \$130.00 required by 37 CFR \$1.17(i)(1), is enclosed.

☐ CERTIFICATION is attended to in box (e) below.

☒ d. The enclosed statement is being filed pursuant to 37 C.F.R. \$1.97(i), for placement in the file.

☐ e. Certification [Check one] [Certification is required only if box (b)(i) or box (c) is checked.]

☐ I hereby certify that each item of information contained in the enclosed Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement,

or

☐ I hereby certify that no item of information in the enclosed Information Disclosure Statement herewith was cited in a communication from a foreign patent office in a counterpart foreign application, or, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. \$1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

or

☐ Appropriate certification is attached.

☒ f. If no check is enclosed and a fee is due in connection with this communication or if the check enclosed is insufficient, the Commissioner is authorized to charge any fee or additional fee due in connection with this communication to Deposit Account No. 19-1980.

Respectfully submitted,

SHERMAN AND SHALLOWAY

Attorney for Applicants

Robert L. Haines

Reg. No. 35,533

SHERMAN AND SHALLOWAY

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet 1

of 12

Complete if Known

Application Number	09/622,002
Filing Date	August 11, 2000
First Named Inventor	OISHI
Art Unit	1714
Examiner Name	M. Medley
Attorney Docket Number	OHS-289

U. S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)				
		JP 2048414	02-19-1990	Mitsubishi Mini		AB
		JP 7061812	03-07-1995	Tateho Kagaku		AB
		JP 2164713	06-25-1990	Mitsubishi Mini		AB
		CN 1148570	04-30-1997	Liu Pin		AB
		JP 3170325	07-23-1991	Mitsubishi Mate		AB
		EP 0 780 425	06-25-1997	Kyowa Chemical		✓

**Examiner
Signature**

Date
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

